

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re: Application of:
Allen Berger, Jr.

Serial No.: 10/669,900

Filed: September 25, 2003

For: "SURFACE MOUNT WINDOW FOR DOORS"

Atty. Dkt. No. 230199.3



Date: November 23, 2005

Art Unit: 3635

Examiner: Robert J. Canfield

BRIEF FOR APPELLANT

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Honorable Board Members:

This is an appeal from the Examiner of Art Unit 3635 finally rejecting claims 1 and 4 on appeal, and for which an amendment after final rejection was presented to the Examiner for the purposes of this appeal. The claims on appeal are included in:

**CLAIMS FILED WITH THE CONTINUATION
APPLICATION (PRELIMINARY AMENDMENT)
SURFACE MOUNT WINDOW FOR DOORS (230199.3)**

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1. A window assembly for garage doors, comprising:

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A) a transparent panel having an external surface and an internal surface, said external surface including a peripheral flange member making said external surface larger than said internal surface with respective external and internal peripheral edges, and said peripheral flange member further including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said internal surface to go through; and

15

B) means for mounting said transparent panel on said garage panel.

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4. The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes:

C) an external frame assembly mounted on said garage panel around said external peripheral edge.

I. Status of Claims

This application is a continuation of application serial No. 10/244,482 filed on September 17, 2002. Initially, Applicant filed a preliminary amendment leaving two claims in this patent application. Claim 1 is derived from the parent application and new claim 4. The amendment filed on April 21, 2005, added the words "coplanarly extending" for clarification purposes. The amendment after final rejection (permitted by the examiner) replaced the word "go" with pass and added the words said opening also for clarification purposes.

II. Status of Amendments

The Examiner entered the amendments mentioned above. The two pending claims read as included in the appendix.

III. Summary of the Invention

The present invention relates to a novel surface mount window for doors, such as overhead garage doors. The invention allows a user to readily mount a window to a panel door that can withstand substantial wind loads.

IV. Issues

Whether the claims are anticipated by U.S. patent No. 5,950,398 under section 102 (b) of Title 35?

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V. Grouping of Claims

There is only one group of claims.

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VI. Argument

15 References relied by the Examiner:

<u>Patentee</u>	<u>Patent No.</u>	<u>Publication date</u>
Hubbard	5,950,398	September 14, 1999

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The Examiner has rejected claims 1 and 4 under 35 U.S.C. §102 (b) as being anticipated by Hubbard. Applicant respectfully disagrees.

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1. The Claimed reference fails to anticipate the claimed invention.

The Examiner has rejected claims 1 and 4 under 35 U.S.C. 102(b), as being anticipated by U.S. patent No. 5,950,398 to Hubbard. Applicant respectfully disagrees. Hubbard shows inner pane or interior glazing 18 that the Examiner has equated to Applicant's internal surface. Inner pane

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18, however, does not pass through the opening of sash 10. Rather, pane 18 is kept "within" the sash, on rabbet 12 abutting against "inner" face 14.

Also, the claimed invention includes peripheral flange members that
5 come in abutting contact against the peripheral external surface adjacent to opening. Hubbard's external surface 17 is also received within the opening, which is contrary to what is claimed herein. In sum, Hubbard teaches away from this invention.

The Examiner states: "If one considers the opening to be defined as
10 the space between reveal 16 and face 14..." p.2 of Advisory Action Before the Filing of an Appeal Brief. This assumption fails to take into consideration the explicit disclosure of the outer surface 13 of Hubbard's double glazed pass-by window unit 11. The real opening of the sash is defined by its outer surface 13. The rabbet 12 is interiorly defined and it is
15 inside the opening. Therefore, the Examiner's assumption is improper.

In claim 1 the peripheral flange comes in contact with the external surface. For Hubbard to anticipate Applicant's claimed invention, the outside panel 17 needs to have a peripheral flange that comes in abutting contact with outer surface 13 and this is not disclosed in Hubbard.

20 Hubbard uses two panes 17 and 18. Applicant only utilizes one. Even if we were to combine pane 18 with pane 17, the combination does

not pass through the opening of a garage door panel opening. Panel 18 is shown in figures No. 3 to be inside the sash.

The Examiner's assumption is not inherent in the type of product described in Hubbard. Rabbets are used for recessing the panels in a sash.

5 This is not intended in the present invention. In this regard, the CCPA has stated that "[I]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oerlich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981). Therefore, the Examiner's analogy is not
10 saved by the limited application of inherency principle to overcome the burden of establishing anticipation.

There is no evidence in the record that one with ordinary skill will equate the internal opening defined by a rabbet or reveal 14 with the true opening of a sash. Nor that causing a panel to come in abutting
15 relationship with reveal 14 puts the claimed invention in the hand of one skilled in the art. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

VII. Appendix
CLAIMS FILED WITH THE CONTINUATION
APPLICATION (PRELIMINARY AMENDMENT)
SURFACE MOUNT WINDOW FOR DOORS (230199.3)

5 1. A window assembly for garage doors, comprising:

A) a transparent panel having an external surface and an internal surface, said external surface including a peripheral flange member making said external surface larger than said internal surface with respective external and internal peripheral edges, and said peripheral flange member further including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said internal surface to go through; and

B) means for mounting said transparent panel on said garage panel.

20 4. The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes: an external frame assembly mounted on said garage panel around said external peripheral edge.

C) an external frame assembly mounted on said garage panel around said external peripheral edge.

CONCLUSION


When this invention and the application's claims are fully analyzed and interpreted as explained above, it will be apparent that there is a good and clear difference between this invention and the cited prior art. When all factors are taken into consideration and given their due weight, it is believed that the Board of Appeals will be able to reverse the Examiner and such is now requested.

Kindly charge or credit our Deposit Account No: 19-0129 for the pertinent fees to cover the appeal brief fee. This Brief is filed in triplicate.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of:
Dab Door Company, Inc.

Date: **December 6, 2005**

Filing Date: **September 25, 2003**

Serial No. **10/669,900**

Attorney Dkt. No. **230199.3**

Title: **"SURFACE MOUNT WINDOW FOR DOORS"**

EXPRESS MAIL CERTIFICATE

"Express Mail" Mailing Label No: **EV 528555128 US**

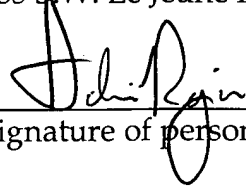
Date of Deposit: **December 6, 2005**

I hereby certify that this paper(s) or fee is hereby being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service pursuant to 37 C.F.R. §1.10 on the date indicated above and is addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450**. I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of this application, document, registration or patent resulting therefrom.

Papers included:

- Transmittal Letter for your accounting purposes with copy
- Brief for Appellant
- postcard

Adrian Rojas, Patent Dept.
235 S.W. Le Jeune Road, Miami, FL 33134



Signature of person mailing paper(s) or fee

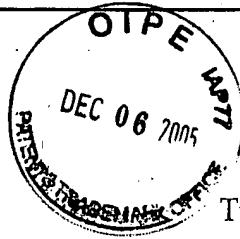
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THW
AF

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Tuesday, December 6, 2005

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
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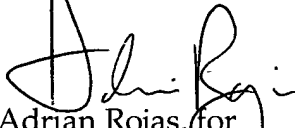
Re: "SURFACE MOUNT WINDOW FOR DOORS"
Serial No. 10/669,900 Examiner: Robert J. Canfield
Filing Date: September 25, 2003 Art Unit: 3635
Applicant: Allen Berger, Jr.
Atty. Dkt. No. 230199.3

Hon. Commissioner:

Enclosed please find the Brief for Appellant for the above-referenced patent application. Kindly charge our **Deposit Account No: 19-0129** for the pertinent fees to file this Brief. A duplicate copy of this charge authorization is enclosed for your accounting purposes.

Please acknowledge receipt of the above by stamping the enclosed self-addressed, postage-paid card and returning it to our office.

Sincerely,


Adrian Rojas, for
Jesus Sanchelima, Esq.

JS/ar
Encl.: Brief & postcard